

REMARKS

Claims 69, 70, 72, and 74 are under consideration in the application. Claims 1 to 68, 71, 73, and 75 to 94 have been canceled without prejudice or disclaimer. Claims 69, 70, 72, and 74 have been amended.

Support for the amendments to claim 69 is found in the specification, e.g., at original claim 40; at page 5, line 31, to page 6, line 1; and at page 17, lines 13 to 20. Support for the amendments to claim 70 is found in the specification, e.g., at page 5, line 31, to page 6, line 1; and at page 17, lines 13 to 20. Support for the amendments to claim 72 is found in the specification, e.g., at page 5, line 31, to page 6, line 1; at page 7, lines 10 to 18; at page 17, lines 13 to 20; and at page 18, line 13, to page 19, line 13. Support for the amendments to claim 74 is found in the specification, e.g., at page 5, line 31, to page 6, line 1; and at page 17, lines 13 to 20.

Thus, the claims are fully supported by the specification and add no new matter.

Drawings

The Examiner objects to the drawings filed on August 4, 2000, by checking box 10 in the Office Action Summary. Applicants have replaced Figures 1 to 44 with the enclosed copies of Figures 1 to 44. The replacement drawings add no new matter.

35 U.S.C. § 112, first paragraph

The Examiner rejects claims 40 to 44 under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled. See Office Action, at page 2, item 2. Solely to expedite prosecution and not acquiescing to the rejection or to any of the Examiner's bases for

the rejection, applicants have cancelled claims 40 to 44 without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of claims 40 to 44 in a related application. Thus, after the amendment, the § 112, first paragraph, rejection is moot.

35 U.S.C. § 112, second paragraph

Claims 69 and 70

The Examiner rejects claims 69 and 70 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite “because the claims do not recite a final process step that clearly relates back to the preamble.” See Office Action at pages 8 to 9, item 4(a). Applicants have amended claim 69 to include the language “wherein the P45 protein enhances the nucleic acid polymerase reaction.” That language relates the process back to the preamble of claim 69. Thus, that amendment should obviate this § 112, second paragraph, rejection of claim 69.

Claim 70 depends from claim 69. Because claim 70 comprises all of the elements of claim 69, the amendment to claim 69 should also obviate this § 112, second paragraph, rejection of claim 70.

Claims 69, 70, 72, and 74

The Examiner rejects claims 69, 70, 72, and 74 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite “for the recitation of PEF because abbreviations often have more than one meaning in the art.” See Office Action at page 9, item 4(b). Applicants assert that the term PEF is clearly defined in the specification. See, e.g., page 17, lines 12 to 24. However, solely to expedite prosecution and without acquiescing to the Examiner’s rejection, applicants have amended claims 69, 70, 72,

and 74 to replace the abbreviation “PEF” with the term “polymerase enhancing factor.” That amendment should obviate this § 112, second paragraph, rejection of claims 69, 70, 72, and 74.

Claims 72 and 74

The Examiner rejects claims 72 and 74 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite “because the claims do not recite a final process step that clearly relates back to the preamble.” See Page 9, item 4(c). Applicants have amended claim 72 to include the language “wherein changing the amount of dUTP present or generated during the reaction controls the activity of the polymerase in the polymerization reaction.” That language relates the process back to the preamble of claim 72. Thus, that amendment should obviate this § 112, second paragraph, rejection of claim 72.

Claim 74 depends from claim 72. Because claim 74 comprises all of the elements of claim 72, the amendment to claim 72 should also obviate this § 112, second paragraph, rejection of claim 74.

Applicants request reconsideration and withdrawal of all the 35 U.S.C. § 112, second paragraph, rejections.

35 U.S.C. § 102

The Examiner rejects claims 40 to 44 under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,605,824. See Office Action at page 10, item 6. Solely to expedite prosecution and not acquiescing to the rejection

or to any of the Examiner's bases for the rejection, applicants have cancelled claims 40 to 44 without prejudice or disclaimer. Thus, the Examiner's rejection is moot.


Applicants request reconsideration and withdrawal of all rejections. Applicants respectfully submit that the application is in condition for allowance. In the event the Examiner does not find the claims allowable, Applicants request that the Examiner contact the undersigned at (650) 849-6658 to set up an interview.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: October 18, 2004

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IN THE DRAWINGS

The attached forty-five (45) sheets of drawings include Figures 1 to 44. These sheets replace the original sheets that include Figures 1 to 44.